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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,883

11/04/2003

David J. Houston

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/605,883

Applicant(s)

HOUSTON ET AL.

Examiner

Mike Chambers

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

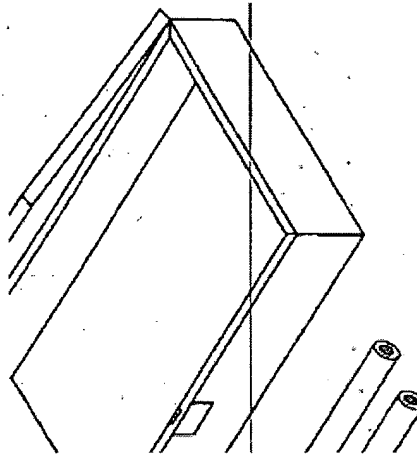
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Drawings***

The drawings were received on 10/5/06. These drawings are acceptable for examination purposes only. The fax drawings have an additional line inserted in 6 of the 10 drawings. An example is shown below.

***Election/Restrictions***

Applicant's election with traverse of claims 1-8 is acknowledged. Applicant's primary argument is that it would not be overly burdensome for the examiner to examine all Groups that have been restricted. As noted in the restriction requirement, the process and product are distinct inventions and the various sub-combinations are usable for different purposes as noted in the prior office action. The serious burden on the examination process comes about due to the different search criteria needed for the different inventions. If the applicant considers these restricted inventions to be obvious variations of the same invention, then they could have noted this on the record. This

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would appear to support the examiner's position that the various sub-combinations are usable as noted in the prior office action. The argument of the applicant also appears to be that the preamble clearly links the inventions. The body of the claim language defines the invention, not the preamble. If claims are found allowable in this case, the applicant can request the withdrawn claims be rejoined. The applicant's argument is not found persuasive. This restriction is made final. Claims 9-26 are withdrawn from further consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Courtney (647220). Courtney discloses a rod assembly including a plurality of threadably connected rod members, said rod assembly configured to be received within the hollow handle; a first bumper element and a second bumper element connected to said rod assembly on opposing ends of said rod assembly; and wherein at least one of said plurality of rod members provides weight at a selected location along the sport stick (fig 1-5).

As to claim 2 : Courtney discloses at least one threaded connector (fig 1,5).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference.

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The mere placement of the device in a sport handle is considered an intended use for the device, which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 4 : Courtney discloses an end cap (fig 1).

As to claim 7 : Courtney discloses a mid bumper (fig 1).

Claims 1-4,6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabat (4132408). Sabat discloses a rod assembly including a plurality of threadably connected rod members, said rod assembly configured to be received within the hollow handle; a first bumper element and a second bumper element connected to said rod assembly on opposing ends of said rod assembly; and wherein at least one of said plurality of rod members provides weight at a selected location along the sport stick (fig 1,2).

As to claim 2 : Sabat discloses at least one threaded connector (fig 2).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference. The mere placement of the device in a sport handle is considered an intended use for the device, which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural

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difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 4 : Sabat discloses an end cap (fig 3).

As to claim 6 : Sabat discloses a threaded insert (fig 3).

As to claim 8 : Sabat discloses a pull cord (fig 3).

Claims 1-4,6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross (5029847). Ross discloses a rod assembly including a plurality of threadably connected rod members, said rod assembly configured to be received within the hollow handle; a first bumper element and a second bumper element connected to said rod assembly on opposing ends of said rod assembly; and wherein at least one of said plurality of rod members provides weight at a selected location along the sport stick (fig 3).

As to claim 2 : Ross discloses at least one threaded connector (fig 3).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference. The mere placement of the device in a sport handle is considered an intended use for the device, which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 4 : Ross discloses an end cap (fig 3).

As to claim 6 : Ross discloses a threaded insert (fig 3).

As to claim 8 : Ross discloses a pull cord (fig 3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKevitt et al (20040142754) in view of Winslow (5328431). McKevitt et al discloses the elements of claim 1, however it fails to clearly disclose the use of a plurality of threaded rod members. Winslow discloses the use of a plurality of threaded rod members(fig 2,3). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the threaded attachment means of Winslow with the apparatus of McKevitt et al in order to better secure the weights in the device and/or to reduce the number of weights needed for the device.

As to claim 2 : McKevitt et al discloses at least one threaded connector (fig 4).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference.

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The mere placement of the device in a sport handle is considered an intended use for the device which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 4 : McKevitt et al discloses an end cap (fig 2).

As to claim 6 : McKevitt et al discloses a threaded insert (fig 5).

As to claim 7 : McKevitt et al discloses a slidable bumper (fig 6).

As to claim 8 : McKevitt et al discloses a pull cord (fig 5).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKevitt et al (20040142754) in view of Winslow (5328431) as applied to claim 1 above, and further in view of Taylor et al (20040248676). Taylor discloses the use of an expanding end cap (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any one of several equivalent end caps including the end cap of Taylor with the apparatus based on cost and design considerations and to increase the user satisfaction by more easily adjusting the weights.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (20040248676) in view of Nolan (5741193). Taylor et al discloses the elements of claim 1, however it fails to clearly disclose the use of a plurality of threaded members. Nolan



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discloses the use of a plurality of threaded members (fig 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the threaded attachment means of Nolan with the apparatus of Taylor et al in order to better secure the weights in the device and/or to more easily obtain the desired weight for the device.

As to claim 2 : Nolan discloses at least one threaded connector (fig 4).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference. The mere placement of the device in a sport handle is considered an intended use for the device which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. *See In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).*

As to claims 4 and 5 : Taylor et al discloses an end cap (fig 2).

As to claim 6 : Nolan discloses a threaded insert (fig 4).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

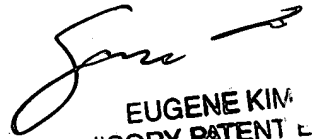
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers  
Examiner  
Art Unit 3711

January 11, 2007

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER